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REMARKS

The Applicant thanks the Examiner for his careful attention to the patent.

The Examiner has rejected the claims of the pending application as obvious. The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *Kahn v. General Motors Corp.*, 135 F.3d 1472, 45 USPQ2d 1608 (Fed. Cir. 1998). In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art and (4) secondary considerations that may be present. Among the factors supporting a finding of non-obviousness are satisfaction of a long-felt need, failure of others to find a solution to the problem at hand, and copying of the invention by others. *Pro-mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996)

In establishing obviousness under section 103, the Examiner carries the burden of presenting a *prima facie* case, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and must show that the references relied on teach or suggest all of the limitations of the claims. *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). Obviousness may not be established using hindsight or in the view of the teachings or suggestions of the inventor. *Para-Ordance Manufacturing, Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995), *cert. denied* 117 S. Ct. 80 (1996).

M.P.E.P. 2142 states:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in

each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

When determining the differences between the prior art and the claims at issue, it is essential to view the claims at issue as "the invention as a whole" 35 U.S.C. §103. It is legally improper to focus on the obviousness of substitutions and differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole relative to that prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), *cert denied*, 480 U.S. 947 (1987).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Thus, while obviousness may be found by combining references, absent a suggestion to combine the references, such combination is inappropriate. *Texas Instruments Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993). It is insufficient that the prior art discloses the component of the claims sought to be patented. A teaching, suggestion or incentive to make the combination is required for a combination of the art to demonstrate obviousness. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). M.P.E.P. 2143.

I. Claims 1, 19, 20 and 2-9

Claim 1 as amended is for a computer system having user input means for identifying a plurality of distinct entities; memory means within a computer storing maintenance information relative to desired maintenance for said plurality of entities; means for building within said computer a schedule of maintenance reminders for each distinct entity based on said maintenance information; and reminder means for providing to a user said maintenance reminders for each distinct entity.

Lallo does not show either means for building within said computer a schedule of maintenance reminders for each distinct entity based on said maintenance information nor reminder means for providing to a user said maintenance reminders for each distinct entity.

Lallo says, "general information about the proper maintenance and service regimen of a given automobile safety and proper care tips about the operation of the car...are available at the web site of the managed auto care provider." Paragraph 0018. However, nothing in Lallo suggests that the information is somehow used for building a schedule of maintenance reminders.

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The Examiner states that Lallo shows a means for creating a maintenance schedule for the customer's vehicle. However, paragraph 0028 of Lallo does not show such a means. Paragraph 0028 states:

The integrated online database network includes the capability for determining and generating a date (or dates) and an automatic reminder system designed to encourage and track customer service follow-up with prospective subscribers into the program of managed automobile repair and maintenance.

Paragraph 28 of Lallo thus makes no mention of creating a maintenance schedule for the customer's vehicle. At best, the paragraph says that an automatic reminder is generated to encourage "customer service follow-up." Thus, the reminder is for "follow-up" to "customer service". There is nothing in Lallo to suggest that "customer service follow-up" means a "maintenance schedule".

Piety is not particularly relevant to the claims of the current application. Piety shows a method of creating a database to help predict when a particular machine might need maintenance. However, Piety shows nothing about what to do with that information.

There is no suggestion to combine Piety with Lallo. Lallo's only reference to maintenance information is "general information about the proper maintenance and service regimen of a given automobile safety and proper care tips about the operation of the car...are available at the web site of the managed auto care provider." Paragraph 0018. Piety, on the other hand, shows a database of specific and highly detailed information regarding "predictive maintenance" for a specific machine. As defined in Piety, predictive maintenance is an effort to predict when a machine will fail or require maintenance so that corrective measures can be taken "as needed." Thus, combining Lallo with Piety makes little sense.

Further, Lallo and Piety cannot be combined. Piety's database for predictive maintenance is unique to a specific machine or assembly to predict when the parts within the machine might fail. As can be seen, the system is Piety 13 for a unique machine. The information in Lallo, on the other hand, is general information applicable to many machines of a particular type. Putting the two systems together would be fruitless.

Thus, the invention of claim 1 is not obvious in view of Lallo and Piety.

Claim 19 is dependent upon claim 1. Claim 19 is not obvious for the same reasons as stated with respect to claim 1. Additionally, claim 19 requires an object database of scheduled maintenance information for the plurality of distinct objects and means for retrieving said scheduled maintenance information from said object database. These new elements are not shown or suggested by Lallo or Piety.

Claim 20 is dependent upon claim 19. Claim 20 is not obvious for the same reasons as stated with respect to claim 19. Additionally, claim 20 requires a means for periodically transmitting to the user the maintenance reminders each transmission containing said maintenance reminders for a corresponding interval of time. These elements are also not shown or suggested by Lallo or Piety. Claim 20 is, therefore, not obvious.

Claim 2 is now dependent upon claim 20. Claim 2 is not obvious for the same reasons as stated with respect to claim 20. Claim 2 adds the element of transmitting the maintenance reminder by one of several different means. The Examiner states that Lallo teaches on-line notification to schedule an inspection of an automobile at Paragraph 0034. The inspection discussed in Lallo is only for pre-approval so that a person might join the system. It is thus not a "maintenance reminder". Thus, claim 2 is not obvious in view of Lallo.

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Claim 3 depends from claim 2. Claim 3 is not obvious for the same reasons as stated with respect to claim 2. Claim 3 adds, among other things, a contact information database containing service providers capable of performing the maintenance contained within a maintenance reminder and where the reminder means includes means transmitting the contact information in the maintenance reminder. Lallo does not show or suggest such a combination.

Claim 4 depends from claim 3 and is not obvious for the same reasons as stated with respect to claim 3. Claim 4 adds the element of a website accessible to the user, the website displaying maintenance reminders and contact information for the service providers. Lallo does not show such a system. The Examiner does not point to any reference showing the element of "a website displaying maintenance reminders and contact information".

Claim 5 is dependent upon claim 4, and is not obvious for the reasons stated previously.

Claim 6 is dependent upon claim 5 and is not obvious for the reasons stated previously. Additionally, Lallo, Baker or Piety do not show a means for transmitting with said maintenance reminders instructions for performing maintenance."

First, Baker does not show "instructions for performing maintenance." Baker says that trouble shooting instructions are provided. "Trouble shooting" is the steps of locating and repairing existing problems within a device. "Maintenance", on the other hand, is upkeep-- i.e., service performed on a device so that a problem will not occur.

Second, the claim require that the instructions be transmitted with maintenance reminders. As pointed out previously, maintenance reminders are not shown in Lallo.

Third, there is no motivation to combine Baker, Lallo and Piety. Lallo shows a business method for providing service to an automobile. Lallo is clear that a user would take the automobile to a qualified mechanic for repair. Thus, a user would have no need to be provided with instruction for performing maintenance, since the user would not be performing the maintenance. One skilled in the art would not put the system shown in Baker with the system shown in Lallo.

Claim 7 is dependent upon claim 6, and thus is also not obvious. Claim 7 also includes the element of the database containing the purpose for performing the maintenance and the reminder means transmits the purpose for performing the indicated maintenance. The Examiner has pointed to no reference that shows transmitting to the user with the maintenance reminder the purpose for performing the maintenance.

Claim 8 is dependent upon claim 7 and thus is also not obvious. Claim 8 further includes means for the user to input a specific schedule period where the reminder means includes means for transmitting the maintenance reminders to said user for the specific schedule period. The Examiner has not pointed out any reference containing this element.

The Examiner indicated that Paragraph 0028 of Lallo is somehow relevant. Applicant respectfully disagrees. Paragraph 0028 does not indicate a specific schedule period or means for transmitting the maintenance reminder for the specific schedule period.

Claim 9 is dependent upon claim 8 and thus is also not obvious.

II. Claims 10-14

As to claim 10, Lallo does not show an object database containing maintenance information for a plurality of object, the object database including information concerning

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scheduled maintenance for each object. Rather, it shows only "general information about proper maintenance and service information." Paragraph 0018. This information is not an object database.

Lallo also does not show building, within the computer, a schedule of maintenance reminders for each of the objects in the list based on the scheduled maintenance information retrieved from said database. First, no database of scheduled maintenance information is shown in Lallo. As stated previously, there is only mention of "general information." Second, there is no creation of scheduled maintenance reminders in Lallo.

Paragraph 28 of Lallo states, "The integrated online database network includes the capability for determining and generating a date (or dates) and an automatic reminder system designed to encourage and track customer service follow-up with prospective subscribers into the program of managed automobile repair and maintenance." At best, this describes an automatic reminder system for customer service follow-up, which is not maintenance. At worst, the paragraph is unintelligible.

Further, paragraph 0028 says nothing about the creation of a maintenance schedule.

The Examiner has not asserted that Lallo shows either (1) periodically transmitting to the user the maintenance reminders, each transmission containing the maintenance reminders for a corresponding interval of time or (2) repeating said inputting, said comparing, said building and said transmitting steps for each separate user to receive maintenance reminders using the same object database.

Neither Lallo nor Piety show "scheduled maintenance information", and thus do not show the element of "comparing, within the computer, the list and the object database, and retrieving the scheduled maintenance information from the object database for each of the objects in the list."

Further, neither Lallo nor Piety show building, within the computer, a schedule of maintenance reminders for each of the objects in the list based on the scheduled maintenance information retrieved from said database.

And, as stated previously, there is no motivation to combine Lallo and Piety.

Claim 11 is not obvious for the same reasons as claim 10. Additionally, claim 11 requires either transmitting or displaying maintenance reminders by a variety of different methods. Lallo shows transmitting a reminder for an inspection in order for a person to be allowed to enter the managed automobile maintenance system, not for maintenance of the automobile.

Claim 12 is not obvious for the same reasons as claim 11. Additionally, claim 12 requires storing within the computer a database of contact information concerning providers capable of performing maintenance indicated in the maintenance reminders or capable of providing products used in performing maintenance indicated in the maintenance reminders. Lallo does not show any such information contained within a database, maintenance reminders, or any association of a provider capable to perform the maintenance or products used in performing the maintenance.

Claim 13 not is obvious for the same reasons as claim 12.

Claim 14 is not obvious for the same reason as claim 13. Additionally, claim 14 includes the step of displaying a list of objects contained in the object database on a website, and selecting on the website the objects from the displayed said list of objects for which the user would like automated reminders. Among other things, Piety does not show the capability to select objects for automated reminder.

III. Claims 15, 16 and 24

Claims 15-16 were rejected as obvious due to Lallo in view of Piety and further in view of Baker.

Claim 15 is not obvious for the reasons stated with respect to claim 14. Additionally, claim 15 is not made obvious by the combination of Baker, Lallo and Piety.

First, even if Baker, Lallo and Piety were combined, the claimed method is not shown. Claim 15 requires among other things "transmitting with maintenance reminders instructions for performing maintenance indicated in the maintenance reminders." Baker does not show "instructions for performing maintenance." Baker says that trouble shooting instructions are provided. "Trouble shooting" is the steps of locating and repairing existing problems within a device. "Maintenance", on the other hand, is upkeep--i.e., service performed on a device whether a problem exists or not.

Second, the claim require that the instructions be transmitted with maintenance reminders. As pointed out previously, maintenance reminders are not shown in Lallo.

Third, there is no motivation to combine Baker, Lallo and Piety. Lallo shows a business method for providing service to an automobile. Lallo clearly anticipates that a user would take the automobile to a qualified mechanic for repair. Thus, even assuming Lallo sent

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reminders to a user, there is no need to transmit instructions for performing the repair to a user since the user has *no need* for the instructions since the repair would not be performed by the user.

Claim 16 is dependent upon claim 15 and requires transmitting with the maintenance reminders the purpose for the repairs. Lallo, Baker and Piety do not show this step, and the Examiner points to nothing in the cited art that shows this step. The assertion by the Examiner that adding the step would be obvious is conjecture.

Claim 24 depends from claim 15. It is likewise not obvious since claim 15 is not obvious. Additionally, it adds the element inputting a specific schedule period and generating a maintenance reminder for the specific schedule period. That element is not suggested by Lallo, Baker or Piety.

IV. Claim 18

Among other things, the Examiner has failed to point out which, if any reference, contains a graphical user interface allowing a user to generate a list, means within the computer for storing a plurality of lists. Neither Lallo, Baker, nor Piety, alone or in combination, show or suggest such a graphical user interface.

The previous arguments that the cited references do not show maintenance reminders is also applicable with reference to claim 18.

Further, the Examiner has not identified the element of Claim 1 that corresponds with Paragraph 0028. One element of claim 1 is, "means within the computer for retrieving said scheduled maintenance information from said object database for each distinct object in said list." However, Lallo does not show scheduled maintenance information is

The Examiner states that Lallo does not "teach means for comparing information related to the customer's object with the database of scheduled maintenance of a plurality of objects." However, that is not an element of the claimed invention.

V. Claim 21-23

Claims 21-23 are new claims.

Claim 21 is for a computer system for providing automated reminders comprising the elements include a user input device for identifying a plurality of distinct entities; a memory within a computer storing a database containing said plurality of entities; a means for building within said computer a schedule of maintenance reminders for each entity in said database; and a reminder means for providing to a user said maintenance reminders for each entity in said database.

Lallo, Piety or Baker, either alone or in combination, fail to show the elements of Claim 21.

Claim 22 is a method for providing automated reminders comprising inputting information into a computer for identifying a plurality of distinct entities; storing in a computer a database containing the plurality of input entities; generating within a computer a schedule of maintenance reminders for each entity in the database of input entities; and providing to a user the maintenance reminders for each object in said database.

Lallo, Piety or Baker, either alone or in combination, fail to show the steps of Claim 22.

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Claim 23 is a dependent upon claim 22 and adds the step of periodically transmitting to the user the maintenance reminders for each object in the database, each transmission containing the maintenance reminders for a corresponding interval of time.

This is also not shown by Lallo, Piety or Baker.

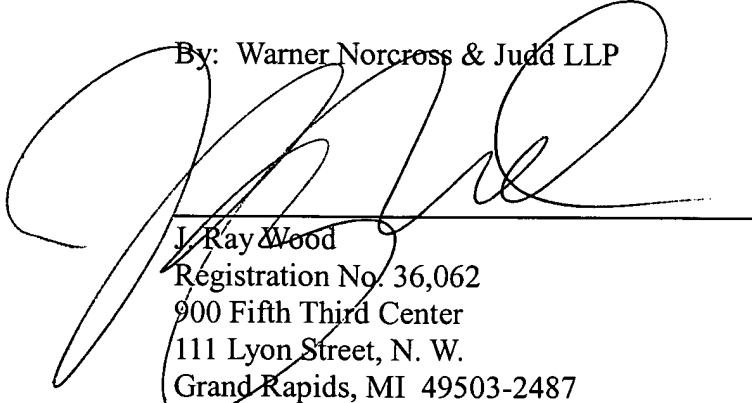
CONCLUSION

In conclusion, the subject application is now in condition for allowance and an action acknowledging the same is respectfully requested. If after reviewing this Amendment, should the Examiner have questions or require additional information, the Examiner is cordially invited to call the undersigned attorney so this case may receive an early Notice of Allowance. Such action is earnestly solicited.

Respectfully submitted,

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